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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,412	10/16/2003	Rafael L. Espinoza	1856-34600 (9808.0-02)	2240
31889	7590	04/06/2006	EXAMINER	
DAVID W. WESTPHAL CONOCOPHILLIPS COMPANY - I.P. Legal P.O. BOX 1267 PONONCA CITY, OK 74602-1267			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,412	Applicant(s) ESPINOZA ET AL.	
	Examiner Cam N. Nguyen	Art Unit 1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006. (amendment/Response)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 and 56-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 & 56-79 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on originally filed is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' amendment and remarks, filed January 03, 2006, has been made of record and entered. Claims 5, 32, & 78 have been amended. Claims 33-55 have been canceled. Claim 79 has been added.

Claims 1-32 & 56-79 are currently and under consideration.

Claim Objections

2. Claim 5 is objected to because of the following informalities: in line 1, "of" should be changed to --for--. Appropriate correction is required.

3. The indicated allowability of claims 5-18 & 65-78 are withdrawn in view of the newly discovered reference(s) to the copending applications cited in the Double Patenting rejections below. Rejections based on the newly cited reference(s) follow.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4 & 19-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 11, 15-16, 20-23, 25-27, 30-31, 34-35, & 37 of copending Application No. **US 2004/0132834 A1** "hereinafter Application '834". Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

First, it is considered there is no patentable distinction between the claimed process and the process disclosed in Application '834 in view of the same average crystallite size of the boehmite recited in claim 37 of the reference.

Second, it is considered the drying and calcining steps (b) and (c) recited in claim 1 of Application '834 embraced by the claimed treating step (b), as recited in the instant claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-4 & 19-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2,5, 7-8, 11,

13, 15, 22, & 23 of copending Application No. US 2004/0132833 A1 "hereinafter Application '833". Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

First, while the disclosed process does not recite the boehmite crystallite size, it is inherent and expected that the same boehmite material would possess the same crystallite size as being claimed.

Second, it is considered the calcining step (B) as recited in claim 1 of Application '833 embraced by the claimed treating step (b), as recited in the instant claim 1.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-32 & 56-79 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-104 of copending Application No. US 2005/0234137 A1 "hereinafter Application '137". Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

It is considered the additional "shaping step" and "applying the catalytic metal to the stabilized support material" ^{step} recited in the disclosed process are embraced by the instantly claimed process due to the phrase "comprising" in the preamble as recited in the independent claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102(e)/103

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 32 & 56-62 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Singleton et al., "hereinafter Singleton", (US Pat. 6,740,621 B2).

Singleton discloses a catalyst containing a catalytic metal supported on an alumina support, thus anticipates the claims.

Product-by-process limitations in the claims is noted. While the catalyst of the reference is not made by the same process, the catalyst made is the same as the claimed catalyst. It is considered the process limitations in the claims have no bearing on the patentability of the product claim itself since it has been held that the patentability of the product and its method of production are separately determined. See, *In re*

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Thorpe, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 173 USPQ 688, 688 (CCPA 1977); In re Fessman, 180 USPQ 324, 326 (CCPA 1977). See, also *MPEP* 2113.

Response to Applicants' Arguments

10. Applicants' amendment and remarks filed on January 03, 2006 has been fully considered, but not deemed persuasive in view of the new ground of rejections above.

Citations

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. All references are cited for related art. See PTO-892 Form prepared attached.

Conclusion

12. Claims 1-32 & 56-79 are pending. Claims 1-32 & 56-79 are rejected. Claim 5 is objected. No claims are allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *cnn*
April 01, 2006

Cam Nguyen
CAM N. NGUYEN
PRIMARY EXAMINER

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